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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,889	09/25/2003	W. Preston Barnes	3227R	2450

26645 7590 02/22/2006

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EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,889

Applicant(s)

BARNES ET AL.

Examiner

Vickey Ronesi

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1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/25/03, 4/21/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement (IDS) filed 9/25/2003 recites three documents under the "Other Documents" section which have been struck from the IDS. The US patent application publications (US 2002/0019320 and US 2001/0036906) are "U.S. Patent Documents" and should be included under such. They have therefore been added to the PTO-Form 892. The PCT application is not a published document and has thus been struck from the IDS.

The Information Disclosure Statement (IDS) filed 4/21/2005 recites a document under the "Other Documents" section which has been struck from the IDS since the WO publication (WO 2005/030913) is a "Foreign Patent Document" and should be included under such. It has therefore been added to the PTO-Form 892.

Claim Objections

2. Claims 1 is objected to because the word "and" should be inserted before ingredient (d). In addition, in part (d), the phrase "metal- or ammonium-containing" should be used in place of either "metal or ammonium-containing" or "metal-or ammonium containing" to be grammatically correct.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, the term "said lubricant" in the penultimate line of the claim lacks antecedent basis.

With respect to claim 20, the term "the components" lacks antecedent basis.

With respect to claims 2-19 and 21, they are rejected for being dependent on a rejected claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-14 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzotto et al (US 6,642,191) in view of L'Heureux (US 6,455,477) or Chamberlin (US 5,422,022).

Palazzotto et al discloses a lubricating oil composition comprising a base oil (col. 4, lines 27-52); 1-8 wt % of a dispersant such as a succinimide which is a product of alkyl-substituted succinic anhydride and a polyamine (col. 7, line 60 to col. 8, line 25); 0.2-3 wt % of a hindered phenol antioxidant such as an ester-substituted phenol antioxidant (col. 6, line 65 to col. 7, line 32); 1-8.5 wt % of a detergent such as low or neutral overbased detergents derived from metal

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(e.g., calcium) sulfonates and phenates (col. 7, lines 46-60); and 0.01-0.11 wt % phosphorus content of a phosphorus wear inhibitor such as phosphorus esters (col. 8, lines 31-59).

Palazzotto et al fails to exemplify combinations of the presently claimed specific ingredients, nevertheless, note that Palazzotto et al teaches that no significant difference was found when using different detergents, dispersants, and wear inhibitors (col. 12, lines 27-34). Thus, it would have been obvious to one of ordinary skill in the art to utilize any combination of detergent, dispersants, and wear inhibitor—absent a showing of unexpected or surprising results.

Palazzotto et al teaches a preferred ash content of 0.10-1.50 wt % (ASTM D874) which is a little higher than the presently claimed range, nevertheless, note that it also teaches that 2-cycle engines require the lubricating oil to be ashless to minimize the extent of harmful deposits that form on the piston and combustion chamber area (col. 11, lines 63-66). Thus, it would have been obvious to one of ordinary skill in the art to prepare a composition with lower amounts of ash than the preferred embodiment of Palazzotto et al for 2-cycle engines.

Palazzotto et al teaches all levels of overbased detergents, including low and neutral overbased detergents, however, it fails to specifically teach Total Base Numbers.

L'Heureux discloses a lubricating oil composition for two-cycle engines and teaches the use of metal (e.g., calcium) phenates and sulfonates as detergents with a total base number of 200 or less (col. 2, lines 54-67). The exemplified detergent has a total base number of 58 (col. 6, line 21).

Chamberlin discloses lubricant compositions and teaches that adding a metal sulfonate detergent with a total base number less than 110 provides superior rust and corrosion inhibition properties (col. 17, lines 44-49).

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Given that Palazzotto et al teaches the use of low and neutral overbased detergents and further given that low overbased detergents are advantageously used in lubricant compositions, including those intended for two-cycle engines, as taught by L'Heureux and Chamberlin, it would have been obvious to one of ordinary skill in the art to utilize a detergent with a total base number below 100 and thereby arrive at the presently cited claims.

5. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Palazzotto et al (US 6,642,191) in view of L'Heureux (US 6,455,477) or Chamberlin (US 5,422,022) and further in view of Tipton et al (US 5,354,485).

The discussion with respect to Palazzotto et al, L'Heureux, and Chamberlin in paragraph 4 above is incorporated here by reference.

While Palazzotto et al teaches the use of phosphorus-containing wear inhibitor (including phosphites, see col. 10, line 24), it fails to disclose triphenyl phosphite.

Tipton et al discloses a lubricating oil for use with two-cycle engines (col. 19, lines 3-4) and teaches the particularly useful triphenyl phosphite as an antiwear agent (col. 16, lines 18-31).

Given that Palazzotto et al is open to the use of phosphorus-derived wear inhibitors (i.e., antiwear agents), it would have been obvious to one of ordinary skill in the art to utilize a known antiwear agent such as triphenyl phosphite as taught by Tipton et al and thereby arrive at the presently cited claim.

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Contact Information

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/15/2006

vr



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